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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,899	01/09/2002	Nicholas L. Abbott	02307Z-085840US	3817
20350	7590	06/10/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			CELSA, BENNETT M	
TWO EMBARCADERO CENTER			ART UNIT	
EIGHTH FLOOR			PAPER NUMBER	
SAN FRANCISCO, CA 94111-3834			1639	

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RESTRICTION / ELECTION

**Office Action Summary**

**Application No.**

10/044,899

**Applicant(s)**

ABBOTT ET AL.

**Examiner**

Bennett Celsa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 121-128 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 121-128 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Applicant's Preliminary Amendment dated 1/9/02 cancelling claims 1-120 and adding new claims 1-8 is acknowledged.

Claims 1-8 are objected to because of the following informalities:

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 1-8 have been renumbered as claims 121-128. ***Status of the***

#### ***Claims***

Claims 121-128 are currently pending.

#### ***Election/Restrictions***

1. This application contains claims 121-128 directed to the following patentably distinct species of the claimed invention: different devices comprising:

A. 1 or more

- "patterned" (e.g. multiple wells , grooves etc. ) or unpatterned and/or
- coated (e.g. Au etc.) or uncoated

SUBSTRATE(S) attached to

B. an optional ORGANIC LAYER(S); attached to

C. an optional MESOGENIC LAYER(S);

D. "LYOTROPIC LIQUID CRYSTALLINE MATERIAL" (e.g. 5CB: spec. p.68); attached to

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E. RECEPTOR (e.g. a ligand-binding recognition moiety; i.e. antibody, pathogen etc.)

The presently claimed invention encompasses different patentably distinct devices which encompass various combinations and subcombinations of the above recited broad categories of components of which separately or in combination which encompass independent and/or patentably distinct devices due to:

lack of any common core structure that elicits a common activity, and/or:  
possession of distinctly different chemical structures; and/or  
different mechanical, chemical physical and/or biological properties; and/or  
which are capable of separate manufacture and/or use; and/or  
have different issues regarding patentability and/or  
require different and individually burdensome manual and/or computer

classification and/or bibliographic searches.

**Accordingly, Applicant is required under 35 U.S.C. 121 to elect:**

For Item A above. the number of substrates (e.g. glass present and a corresponding name or chemical structure corresponding to each substrate(s) and

- if patterned, a specific species of patterning (e.g. wells, grooves etc.);
- if coated, a specific species of coating material (e.g. gold etc.);

For Item B above: *if present*, a specific chemical species corresponding to the organic layer (s);

For Item C above: *if present*, a specific chemical species corresponding to the mesogenic layer(s);

For Item D above: a specific species (e.g. a specific compound) corresponding to the lyotropic liquid crystalline material;

For Item E above: a specific receptor type (e.g. antibody, enzyme, surface receptor) and a corresponding specific ligand species (e.g. a specific antigen, substrate or receptor ligand).

APPLICANT MUST FURTHER INDICATE the interrelationships ( especially upon the election of multiple components e.g. more than one substrate, coating or layers) of the above items to each other e.g. how each components is attached to each of the other components.

*Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.*

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bennett Celsa whose telephone number is 571-272-0807. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-273-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BC  
June 4, 2004

Bennett Celsa  
Primary Examiner  
Art Unit 1639

